

REMARKS

In light of the Examiner's comments, reconsideration of the application as amended is respectfully requested.

A. Allowable Subject Matter (Claims - 23-33, 36, 40-50, 53, 58-69, 72 and 89-92)

Applicant wishes to thank Examiner for signifying the allowable subject matter contained in claims 23-27, 36, 40-44, 53, 72, 82-85 and 89-92. Consistent with the Examiner's observations, claims 23, 26, 28, 29, 32, 36, 40, 43, 45-46, 49, 53, 58-60, 63-65, 68, 72 and 89 have been amended to include the allowed subject matter. To the extent that the Examiner has suggested that the medium invention of claims 58-69 and 72 might be read not to include the recited "instructions", the preamble has been amended for these claims to clarify that the medium does include such "instructions". Thus, consistent with the suggestions of the examiner, claims 23-33, 36, 40-50, 53, 58-69, 72 and 89-92 are in condition for allowance.

Applicant has cancelled claims 86, 93 and 100 without prejudice for prosecution in a divisional application.

B. Objection to Claims 58-60, 81, 82, 88, 89, 95 and 96

In accordance with the Examiner's comments concerning the preambles of claims 58-60, 81, 82, 88, 89, 95 and 96, these claims have been amended to correct the inadvertent incongruity. Applicant submits that the claims are now in condition for allowance.

C. Rejections of Claims (80-85, 87, 88, and 94-99)

Examiner has rejected the inventions of independent claims 80, 87 and 94 under 35 U.S.C. § 102(b) as being anticipated by International Patent Application to Brydon, WO 98/52467. An invention is anticipated under § 102 if the same device, including all the claim limitations, is shown in a single prior art reference. *Richardson v. Suzuki Motor Co. Ltd.* 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Every element of the claimed invention must be literally present, arranged as in the claim. *Perkin-Elmer Corp v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir.), cert. denied, 469 U.S. 857 [225 USPQ 792] (1984); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 [224 USPQ 520] (1984). The identical invention must be shown in as complete detail as is contained in the patent claim. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985); *Connell v. Sears*,

Roebuck & Co, 722 F.2d 1542, 1548, 220 USPQ 193,198 (Fed. Cir. 1983). For the following reasons, Applicant requests that the Examiner reconsider the rejection of the claims as amended.

The Examiner properly recognizes that Brydon discloses a CPAP treatment apparatus with the ability to raise or lower its treatment pressure in response to detected obstructive events. However, the disclosed apparatus is only described as providing a generally continuous level of pressure over the course of a single breathing cycle. Brydon, p. 28, line 24 to p. 29, line 2. Those skilled in the art would recognize that the disclosed changes in the therapeutic level of the pressure would be considered a change in the degree of the CPAP treatment but not a change in the type of the CPAP treatment that is being provided by the device. That is, regardless of whether the treatment pressure is increased in response to a detected event of obstruction, the type of the disclosed treatment is still continuous positive airway pressure that will deliver a newly selected pressure level continuously over the course of a single breathing cycle.

Conversely, the apparatus of the current invention utilizes a scheme for changing between different types of CPAP treatment in the apparatus as a function of an apnea hypopnea index. Specification, p. 7, line 34 to p. 10, line 21. For example, as disclosed in the specification, the CPAP apparatus may be configured to change between CPAP types that deliver (a) a generally continuous level of treatment pressure over the course of single breathing cycle (specification, p. 4, lines 28-30), (b) a bi-level treatment changing between higher and lower pressure levels with each inspiration and expiration of the patient (Specification, p. 4, line 36 to p.5, line 4) or a smooth comfortable waveform simulating patient respiration as disclosed in WO 99/61088 (Specification, p. 5, lines 14-15).

To this end, claims 80, 87 and 94 define the limitation of a device programmed to determine an index of the a total number of hypopneas and apneas, comparing the index to a threshold and then selecting "between different types of CPAP treatment." Brydon does not disclose such a device. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of amended claims 80-85, 87, 88, and 94-99. These claims define novel and non-obvious subject matter not disclosed in the prior art.

D. Claim 104

In the Examiner's original restriction requirement claim 104 was included in Group 1, the group that Applicant elected. In Applicant's original election claim 104 was expressly identified as a claim elected for consideration in the current application. Due to a typographical error original claim 104 was listed as claim 103 repeating the number of the immediately preceding claim 103. Thus, it appears that claim 104 was inadvertently overlooked. Accordingly, Applicant requests that the Examiner reconsider claim 104.

For the aforementioned reasons, it is submitted that this Amendment now places the application in condition for allowance. Should the Examiner believe that anything further is desirable to expedite allowance of the application, he is invited to contact the undersigned at the telephone number listed below. Early and favorable action is therefore requested.

Respectfully submitted,
GOTTLIEB, RACKMAN & REISMAN, P.C.
Attorneys for Applicant
270 Madison Avenue
New York, New York 10016
Phone: (212) 684-3900
Fax: (212) 684-3999

12/16/2003
Date


Raymond B. Churchill, Jr. (Reg. No. 44,617)